

U.S. Patent Appln. No. 09/910,271
Amendment Dated Mar. 16, 2003
Reply to Office Action of Dec. 18, 2003
Docket No. BOC9-2000-0060 (195)

REMARKS / ARGUMENTS

These remarks are made in response to the Office Action of December 18, 2003 (Office Action). As this response is filed within the three-month shortened statutory period for reply, no fee is believed due.

In paragraphs 2 and 5 of the Office Action, claims 1-37 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0076025 to Liversidge, *et al.* (Liversidge). It appears that the 35 U.S.C. § 102(e) rejection was maintained because Applicants' affidavit under 37 C.F.R. § 1.131 was deemed insufficient to establish conception of the invention prior to the effective date of Liversidge. The Office Action notes that while due diligence was alleged in the affidavit, no evidence of due diligence was submitted.

In response, the Applicants submit herewith documentation evidencing due diligence from prior to the effective date of Liversidge (December 18, 2000) through the filing of the instant application (July 19, 2001). Enclosed, please find the following documents:

- Applicants' Confidential Invention Disclosure evidencing conception at least as early as June 7, 2000;
- Letter from International Business Machines Corporation (IBM) forwarding the Confidential Invention Disclosure to Counsel dated October 2, 2000;
- Letter from Counsel to IBM acknowledging receipt of the Confidential Invention Disclosure dated October 11, 2000;
- Redacted time sheet from Counsel's billing system indicating that preparation of the instant patent application began as early as December 5, 2000;
- Letter from Counsel to IBM forwarding a draft version of the patent application dated May 1, 2001;
- Letter from Counsel to IBM forwarding a final version of the patent application dated July 6, 2001; and
- Excerpts from Counsel's docketing system listing the status of the patent application as "in process" or "in progress" as early as January 2, 2001.

As noted in the Applicants' previous response and affidavits, the Applicants conceived of the instant invention at least as early as June 7, 2000. Confidential Invention Disclosures

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typically undergo a review process within IBM to determine whether patent protection will be pursued for any given invention. After a decision to file for patent protection was made as a result of this process, the Confidential Invention Disclosure was forwarded to Counsel on October 2, 2000. Counsel acknowledged receipt of the Confidential Invention Disclosure on October 11, 2000, and noted that every effort would be made to file a patent application for the technology discussed in the Confidential Invention Disclosure on or before April 2, 2001, a standard time period for preparing and filing patent applications.

The Confidential Invention Disclosure then underwent Counsel's own intake procedure. In particular, the Confidential Invention Disclosure was listed in Counsel's docketing system and scheduled for work with an appropriate attorney. In fact, Counsel's file copy of the acknowledgement letter sent to IBM lists the docketing entries that were made. As noted in the top left-hand portion of Counsel's acknowledgement letter to IBM, the case was docketed for reminders on January 2, 2001, March 2, 2001, and April 2, 2001.

The redacted time sheets from Counsel's billing system indicate that preparation of the patent application began at least as early as December 5, 2000, and again on April 17, 2001. Additionally, in and around October 11, 2000, counsel relied upon a paper-based docketing system. The attached docketing sheet for January 2, 2001, lists the status of this application as "in process". The remaining docketing sheets for March 2, 2001, April 2, 2001, May 2, 2001, June 2, 2001, and July 3, 2001, provide similar indications. In any case, an initial draft was completed and forwarded to IBM for review on May 1, 2001. A final draft was forwarded to IBM on July 6, 2001. The application was ultimately filed on July 19, 2001.

The Applicants believe that the above explanation and enclosed supporting documentation proves that Applicants exercised due diligence from prior to the effective date of Liversidge and that such due diligence continued from that time through the filing of the instant patent application on July 19, 2001. The time periods described above as well as the progress toward filing the instant patent application both are common with respect to this art and demonstrate the due diligence exercised.

The Applicants believe that the previously submitted affidavits, when taken in combination with the above explanation and supporting documentation, are sufficient to


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overcome *Liversidge*. Accordingly, withdrawal of the 35 U.S.C. § 102(e) rejection with respect to claims 1-37 is respectfully requested.

The Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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